

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

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NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Rule 71.1)

Date of mailing
(day/month/year) 28.07.2004

Applicant's or agent's file reference
PL 145 PCT

IMPORTANT NOTIFICATION

International application No.
PCT/FI 03/00324

International filing date (day/month/year)
23.04.2003

Priority date (day/month/year)
24.04.2002

Applicant
COMPTEL CORPORATION ET AL.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international preliminary examining authority:



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PATENT COOPERATION TREATY

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Article 36 and Rule 70)



Applicant's or agent's file reference PL 145 PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA416)	
International application No. PCT/FI 03/00324	International filing date (<i>day/month/year</i>) 23.04.2003	Priority date (<i>day/month/year</i>) 24.04.2002
International Patent Classification (IPC) or both national classification and IPC G06F17/60		
Applicant COMPTEL CORPORATION ET AL.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 7 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

 These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application

Date of submission of the demand 10.10.2003	Date of completion of this report 28.07.2004
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Gabriel, C Telephone No. +49 89 2399-7112 

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**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/FI 03/00324

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-9 as originally filed

Claims, Numbers

1-14 as originally filed

Drawings, Sheets

1/2-2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/FI 03/00324

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	10,11
	No: Claims	1-9,12-14
Inventive step (IS)	Yes: Claims	
	No: Claims	1-14
Industrial applicability (IA)	Yes: Claims	1-14
	No: Claims	

2. Citations and explanations

see separate sheet

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Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. The following documents (D1-D2) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: EP-A2-1263187

D2: WO-A1-0024161

2. The subject-matter of independent claims 1, 12 and 14 is not new for the following reasons:

- 2.1 Document D1 discloses, according to all the features of claim 1,

a method for managing customer accounts in connection with a Pre-Paid platform ("24"- "27" in figure 1), in which method

- the applications communicate with the Pre-Paid platform (sending SMS "content" to the "service mediator 24" in paragraph 25)
- the applications ("SMS" in paragraph 25) are arranged to communicate with a proxy ("service mediator 24" in paragraph 25) and the Pre-Paid platform correspondingly with a charging module ("sends an SDR...to the Telecom Service Provider's billing services" in paragraph 25), in which case the proxy and the charging module communicated with each other in a logically predefined manner ("XML" in figure 1; "a unified standard language within the service mediator/payment/billing server modules such as XML" in paragraph 25), in which case
- the proxy is used to collect and manage the services used by the customers ("check whether the customer is entitled to the content service" in paragraph 25), the charging models, and the rating ("too little funds on the pre-paid account" in paragraph 39; "tariff" in paragraph 37), and
- the charging module is used to bill the customer's Pre-Paid account, which is located on the Pre-Paid platform, or in a system behind it ("sends an SDR...to the Telecom Service Provider's billing services" in paragraph 25).

As a consequence, claim 1 does not meet the requirements of the PCT for lack of novelty of its subject-matter, Articles 33(1) and (2) PCT.

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It should be noted in this respect, that the expression "platform" is interpreted as the combination of a computer's hardware and software, analogous to the meaning this expression has in the relevant art.

It should further be noted that the subject-matter of claim 1 is also not new vis-a-vis to the disclosure of document D2 (figure 1; page 7, line 1 - page 9, line 26), which also discloses a method involving an intermediate system for collecting and managing services and charging Pre-Paid accounts.

- 2.2 With respect to the objection raised in item 2.1 above, independent claims 12 and 14 do also not meet the requirements of Articles 33(1) and (2) PCT due to lack of novelty of their subject-matter.

Apparatus claim 12 and computer software product claim 14 correspond to apparatus claim 1, whereby all the features of the apparatus and computer software product are represented by corresponding method steps.

3. Dependent claims 2-11 and 13 do not appear to contain any additional features or method steps which, either alone or in combination with the features or method steps of any claim to which they refer, meet the requirements of the PCT with respect to novelty or inventive step, because the subject-matter of these claims relates to minor design details and is either directly derivable from the above mentioned prior art or presents standard practice. In detail:

- 3.1 The feature of claim 2, of collecting charging information and using a charging module, are known from document D1 (paragraphs 25 and 37; claim 14) or document D2 (page 7, line 7-29).
- 3.2 The feature of claim 3, of using different charging models, are known from document D1 (paragraph 10; fig. 5; claim 15) or document D2 (page 7, line 7-29).

Moreover, this feature is non-technical, whereas the subject-matter of the claims should be defined using technical features (Rule 6.3(a) PCT).

- 3.3 The feature of claims 4 and 6, of controlling delivery of the service, are known from document D1 (abstract; paragraph 39; claim 14) or document D2 (page 8, line 17-25).

- 3.4 The features of claims 5 and 7-11, of converting charging data into data that can be interpreted by an existing billing system, are either obvious for being able to implement billing using existing systems, or are known from document D1 (paragraph 25) or document D2 (page 6, line 9-21; page 7, line 1 - page 8, line 16).
- 3.5 The feature of claim 13, that the proxies are not in direct contact with the Pre-Paid platform, are known from document D1 (figures 1, 5).

Moreover, the subject-matter of this claim is defined using negative features, whereas positive features should be used (Article 6 PCT; PCT Guidelines III-4.12).

- 3.6 As a consequence, dependent claim 2-11 and 13 do not meet the requirements of Articles 33 (1)-(3) PCT due to lack of novelty or inventive step of their subject-matter.
4. The present application does not meet the requirements of Article 6 PCT in that the matter for which protection is sought is not clearly defined. The reasons are the following:
- 4.1 It is evident from the description on page 4, second paragraph, that it is essential to the definition of the invention that "charging data can be transmitted prior to call connection or an SMS transmission, allowing the system to prevent the provision of services, if there is no money in the account". Since **any independent claim must contain all the technical features essential to the definition of the invention** (Rule 6.3(a),(b) PCT; PCT Guidelines III-3.4), the technical features achieving this result should have been added to the independent claims.
- 4.2 The "computer Software Product" of claim 14 fulfills the requirements of the PCT only if it defines all the essential technical features of the process which the program is intended to carry out when it is run (PCT Guidelines IV-2.4 (f)). In the present case, it is not clear whether the expression "implements" in claim 14 assures that **all** steps of claim 1 are performed when the program is run on a computer.

The following wording would have met the requirements of the PCT:

"A computer software product containing a computer software program which,

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upon execution, carries out all the steps of the method of claim 1"

- 4.3 The antecedents are missing for "the applications" in claim 1 and "the call's B-number" in claim 5.
- 5. In addition, the following requirements should also have been attended to:
 - 5.1 The features from prior art document D1 should have been placed in the preamble as required by Rule 6.3 (b) (i) and (ii) PCT.
 - 5.2 The above-mentioned documents D1-D2 should have been acknowledged in the description (Rule 5.1 (a) (ii) PCT).